



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0945-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Vincent DE LAFORCADE) Group Art Unit: 3732
)
Application No.: 09/902,092) Examiner: R. Doan
)
Filed: July 11, 2001)
)
For: FOAM CORE COSMETIC CASE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

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REQUEST FOR RECONSIDERATION

In response to the Office Action of November 28, 2003, the period for response to which has been extended to March 29, 2004 (March 28, 2004 was a Sunday) by the Petition for a one-month Extension of Time and fee payment filed herewith, Applicant respectfully requests that the Examiner reconsider the present application and withdraw the claim rejections for the reasons explained in detail below.

In the Office Action, claims 1, 2, 4, 5, and 7-25 were rejected under 35 U.S.C. § 103(a) based on Skarne (U.S. Patent No. 6,055,992) in view of Neckermann et al. (U.S. Patent No. 3,496,575). Claims 1, 4, and 16 are the only independent claims rejected under § 103(a) based on those references, and Applicant respectfully traverses the rejection of those claims because the Office Action fails to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, among other requirements, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one having ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2142. In other words, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Id. at § 2143.01 (citation omitted).

As will be explained in more detail below, the Office Action fails to establish that any of Applicant's independent claims 1, 4, and 16 are *prima facie* obvious at least because there is no suggestion or motivation to modify the Skarne reference in view of the Neckermann et al. reference in the hypothetical manner proposed in the rejection statement. Accordingly, Applicant's independent claims 1, 4, and 16 are not *prima facie* obvious, and therefore, the Office Action's rejection under 35 U.S.C. § 103(a) based on Skarne in view of Neckermann et al. is improper and should be withdrawn.

Applicant respectfully submits that the Office Action has not established that there would have been any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Skarne cosmetic compact based on the teachings of Neckermann et al.'s carry-all hat. Rather, the Office Action asserts a mere unsupported conclusion that Neckermann et al.'s disclosure relating to carry-all hats could be combined with Skarne's cosmetic compact. In so doing, the Office Action has simply used Applicant's own teachings against him.

Applicant's independent claim 1 recites a cosmetic product including, in pertinent part, a foam core and "a covering material covering at least a portion of the foam core and defining an exterior surface of the cosmetic product. . . ." The Skarne reference does not disclose at least that subject matter recited in Applicant's claim 1.

The Office Action apparently concedes that the Skarne reference does not disclose the above-recited subject matter by explaining that "Skarne does not disclose a fabric covering material covering at least a portion of the foam core and defining an exterior surface of the cosmetic product. . . ." Office Action at 3. Nevertheless, the Office Action attempts to overcome this acknowledged deficiency in the Skarne reference by relying on the Neckermann et al. reference as disclosing "a container (fig. 3) having a decorative stitched exterior (fabric); the container further having a recess containing a cosmetic composition (lipstick 34)." Id. The Office Action thereafter concludes that it would have been obvious to one skilled in the art "to employ the covering material as taught by Neckermann et al into the cosmetic container of Skarne for the purpose of providing aesthetic look. . . ." Id. Applicant respectfully disagrees with the Office Action's legally improper conclusion.

First, there is absolutely no suggestion or motivation to make the Office Action's proposed, hypothetical combination. The Skarne reference discloses a cosmetic compact including a housing 20, a mirror 22, and an inner cosmetic compartment 24 that contains make-up powder. The housing 20 is composed of an elastomeric foam, such as a polyurethane or rubber foam. The exterior of the housing "preferably" has a matte surface. Col. 2, lines 12-13. The housing 20 includes two coextensive flaps 26

and 28 for holding the mirror 22 and the cosmetic compartment. The flaps 26 and 28 are hinged integrally at anchor region 30.

The Skarne reference does not disclose a covering material covering at least a portion of a foam core and defining an exterior surface of a cosmetic product. Nor does the Skarne reference contain any teaching, either explicit or implicit, of providing the Skarne cosmetic compact with any surface or covering other than the "prefer[red] . . . matte surface" discussed in the reference. Simply stated, Skarne does not recognize or suggest even a need for providing a covering to the Skarne cosmetic container. Accordingly, there would have been no reason for one of ordinary skill in the art to make any modification to that structure.

Turning to the Neckermann et al. reference, that reference discloses a carry-all hat 10 having upper and lower vertically separated compartments 16 and 18, respectively. A bottom end of the lower compartment 18 is open and serves as a head receiving cavity for the wearer of the hat 10. The upper compartment 16 contains removable objects such as lipstick 34, a hairbrush 36, and/or pill boxes 38. The hat 10 may have either a generally cylindrical shape (Figs. 1 and 3) or a generally square shape (Fig. 2) and may include an outer beaded, stitched, or otherwise shaped, decorated surface 12. A partition 14 divides the hat 10 into the upper compartment 16 and lower compartment 18. A top horizontal lid 28 is hingedly secured the upper compartment 16 and provides access to the interior of the upper compartment 16 and may carry a decoration 32, which serves as a knob for opening and closing the lid 28. Feathers 42 may also be secured to the periphery 40 (Fig. 5) for decoration.

Neckermann et al.'s carry-all hat is not cosmetic compact. It is a hat. No one having ordinary skill in Skarne's art relating to cosmetic compacts would look to Neckermann et al.'s disclosure relating to hats for guidance. Furthermore, as discussed above, since the subject matter disclosed in Skarne provides a preferred matte exterior surface, Skarne teaches away from any modification that would destroy that preferred subject matter. Thus, there would have been no suggestion or motivation in either the Skarne reference, the Neckermann et al. reference, or elsewhere, to make the Office Action's proposed, hypothetical modification to the Skarne cosmetic compact.

Therefore, there is no legally proper suggestion or motivation to modify the Skarne cosmetic compact in view of the Neckermann et al. hat. Accordingly, independent claim 1 should be allowable. Furthermore, since remaining independent claims 4 and 16 were rejected based on the Office Action's legally improper combination of the Skarne and Neckermann et al. references, those claims should also be allowable for at least reasons at least similar to those outlined above with respect to claim 1.

In the Office Action, claims 3 and 6 were rejected under 35 U.S.C. § 103(a) based on Skarne combined with Neckermann et al. and Gueret (U.S. Patent No. 5,865,194). Since claims 3 and 6 depend from independent claims 1 and 4, claims 3 and 6 should be allowable for at least the same reasons claims 1 and 4 should be allowable.

Conclusions

For at least the reasons set forth above, independent claims 1, 4, and 16 should be allowable. Claims 2, 3, and 19-21; claims 5-15 and 22-25; and claims 17 and 18, depend from independent claims 1, 4, and 16, respectively. Consequently, those dependent claims should be allowable for at least the same reasons that claims 1, 4, and 16 are allowable.

Applicant therefore respectfully requests the reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 1-25.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned representative at 571-203-2739.

Applicant respectfully submits that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: March 29, 2004

By



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